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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/314,001 05/19/99 ASLANOVA

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EXAMINER

HOFFMANN, J

ART UNIT

PAPER NUMBER

1731

DATE MAILED:

01/05/01

Please find below and/or attached an Office communication concerning this application r proceeding.

Commissioner of Patents and Trademarks



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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 12-1-00

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire Three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-7 & 19 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-17 & 19 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 10
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

—SEE OFFICE ACTION ON THE FOLLOWING PAGES—

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DETAILED ACTION

Election/Restriction

New claim 19 links inventions I and II.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the stabilizing of the glass mass volume in a stabilizing section must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

The figure shows that the stabilization of the volume occurring in the firing space 4, but the claim requires the stabilization occurs in the stabilizing section 6. Specifically, page 4, lines 24-25 indicates that the stabilization creates a smooth and even surface - but the drawing shows that the glass has a smooth and even surface prior to stabilizing section 6.

Claim Rejections - 35 USC § 112

Claims 1-7 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In re Donaldson, 16 F.3d at 1193, 29 USPQ2d at 1850 says "if one employs means-plus-function language in a claim, one must set forth in the specification an adequate disclosure

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showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112.” There is no mention for any of the “means” of claim 19. One of ordinary skill would be at a complete loss as to what the various means are. For example, there is no mention of any structure which stabilizes. The specification refers to a “stabilizing section” but that merely defines the location of the stabilization - there is nothing which performs the function of stabilizing. IN ADDITION, 35 USC 112, paragraph 6 indicates that means plus function limitations are construed to cover the corresponding structure described in the specification and equivalents thereof. But there is no indication what the corresponding structure is.

Claim 1: it is unclear what is meant by “stabilizing the glass mass volume”. First there is no explicit definition for this term. Second, although page 4, lines 21-26 discusses this stabilization, it is unclear if such is to serve as a definition and what that definition is. Third, the top of page 5 of the specification says that the exit of gas and foam is merely “possible”, but in paper 9 Applicant argues that it is mandatory. One of ordinary skill would be at a loss trying to determine what is required by this stabilization.

It is unclear what is meant by “stabilizing constituents”. Whereas there is no definition of this term, there doesn’t even seem to be any mention of this term. Although there is mention of “ensuring the relation of constituents in the composition” (page 5, line 16-17) it is unclear if this is what is meant by the limitation, or if it includes “averaging the mass” - as Applicant seems to

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argue in paper 9 page 7. Furthermore, Examiner is at a complete loss as to what is meant by averaging a mass or ensuring a relation of constituents. For these reasons it is deemed that one of ordinary skill would also fail to understand what is required by this limitation.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no support for the means plus function limitations of claim 19. By 35 USC 112 (para. 6) all means plus function limitation cover the equivalents to the corresponding structure described in the specification. There is no support for any such equivalents. These equivalents are new matter. Also, there is no support for any means for stabilizing the glass - examiner could find no explicit or implicit support for any such structure which stabilizes the glass.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the

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following is required: There is no antecedent basis in the specification for the various means of claim 19.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austin 4149866 in view of Shofner 4343637 and Naber 4940478.

Austin discloses the composition of the invention and the use of basalt: see col. 2, line 48- col.3, line17. However, Austin does not go into much detail as to how the melt is created. Although Austin does not mention the ratios, they are inherently met by at least one of the specific compositions disclosed by Austin.

Naber teaches that it is desirable to preheat basalt when making fibers: col. 1, lines 6-8 and 31-34. This is to save energy/money: col. 2, lines 19-23. It would have been obvious to practice the Austin invention by using preheat of the basalt as taught by Naber for the reasons of Naber.

Shofner teaches using a furnace (12) and a forehearth (18) to produce fibers from basalt. Austin fails to disclose what sort of apparatus is used. It would have been obvious to use the Shofner apparatus to form the fibers, because some sort of apparatus is needed and for the

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advantages that Shofner discusses. Looking at the attached enlarged Shofner figure. It is clear from the drawing that the glass obtains an even and smooth surface within the stabilization section. It is inherent that the glass temperature and viscosity is stable enough to make the fiber. Thus, the glass is deemed to be stabilized in volume in that it meets Applicant's description at page 4, line 34-26.

As to the second stabilizing: in the Shofner feeder the glass would still be homogenizing - thus it isn't stable - it's still changing. Alternatively, since the glass constituents are flowing it is unstable from a kinetic energy standpoint. They are stabilizing further.

As to claim 3, it would have been an obvious matter of routine experimentation to determine the optimal glass temperature. Clearly, if the glass was near or below the melting temperature it would be too stiff to draw a fiber therefrom. And if it was very much above the melting point, it would be too fluid - water like - to draw a fiber therefrom.

Claim 5: see Table 3. It would have been obvious that the feeder would be at a temperature near the claimed range.

Claim 2, 6 and 4: See col. 7, line 9-11 of Naber. It is clear that the basalt would be heated at least one temperature within the claimed range for at least one portion of the process.

Claim 7: see how claim 3 is addressed.

Claim 19: It would have been obvious to perform the obvious process with a single apparatus because it would save space and money to keep everything in one location. Although this obvious combination does not have the same apparatus as disclosed. It is deemed that such

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would be equivalents thereto because: 1) they carry out the claimed function of the means plus function limitations, 2) applicant has failed to explicitly define the various means in such a manner which would exclude any means that can carry out the claimed functionality.

Response to Arguments

Applicant's arguments filed 1 December 2000 have been fully considered but they are not persuasive.

The arguments regarding the first stabilization are now moot in view of the altered rejection (above) necessitated by amendment to the claims.

It is argued that invention is allowable because the melt becomes stable in volume because gas bubbles and foam are expelled. The claims do not require this: there is no explicit requirement in the claims; page 5, line 1 and page 4 lines (21-24) states that such is merely "possible"; and it is clear from the drawing that there is no foam in the stabilizing section 16.

It is further argued that the glass is kept in the stabilization section until it reaches the fiber manufacturing temperature. This is an extremely broad limitation - there is no definition for this term. This temperature could be the temperature of the fibers as drawn, the temperature of the flames of attenuation burners, the temperature of the fibers as they are being coated - in fact it could relate to the temperature of some other fiber making process. It is clear that whatever temperature the combination of reference would have, that there is some temperature in a fiber manufacturing process that is equal to it. In fact, since the Shofner temperature is equal to itself,

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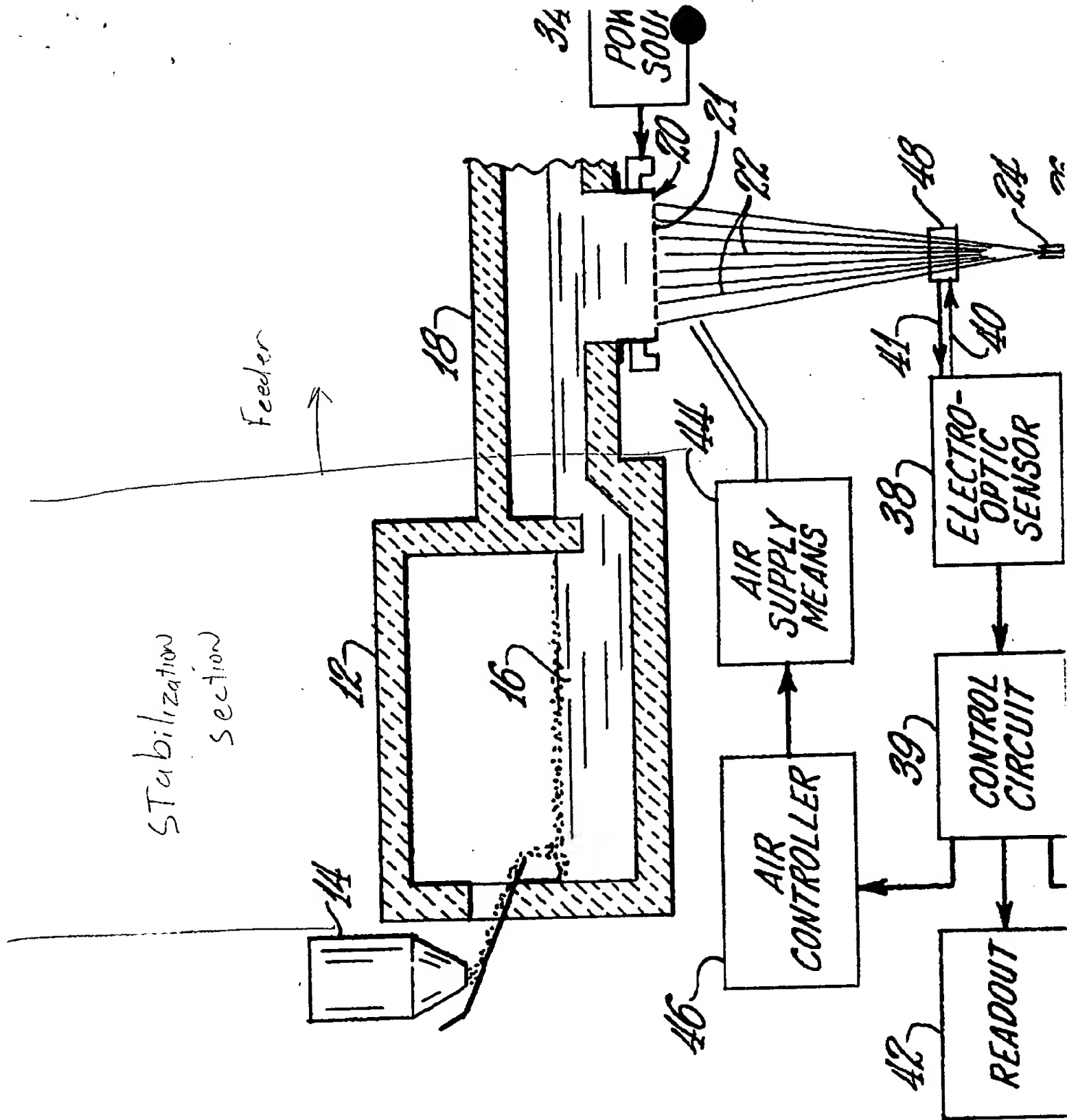
and since it is glass used in a fiber manufacturing process, it is "a fiber manufacturing temperature."

It is still further argued that the invention has averaging of mass and obtaining the needed relation of constituents. The claims are not so limited. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



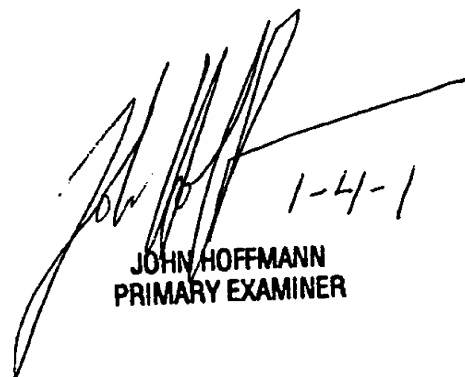
Requests for interviews

The Office initiates interviews whenever it is deemed that it would be beneficial to do so to advance prosecution. And when an Applicant wishes to have an interview, the burden to initiate the interview remains solely with Applicant. MPEP 408 notes that Examiners are not required to note or acknowledge requests for telephone calls or state reasons why such proposed telephone interview would not be effective; therefore, requests for the Office to initiate interviews will not be acknowledge.

MPEP 713.05, 713.03, 713.09, and 713.01 and common sense indicate that any of the following questions would be appropriate for the Office to ask prior to granting an interview: Has there already been an interview of record in the case? Will the interview last more than 30 minutes? When do you want the interview? Does Applicant's representative have Power of Attorney? Does Applicant's representative have authority to bind the principal concerned? (i.e. Does Applicant's representative have authority to make any and all changes?) Who will participate in the interview? What is the intended purpose(s) of the interview? What is the intended content of the requested interview? Failure to volunteer the above information might possibly result in a denial of an interview, or the inability of the Examiner to adequately answer Applicant's questions during the interview.

CONTACT INFORMATION

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1-4-1
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PRIMARY EXAMINER